

REMARKS

Claims 1-57 were pending in the present application. By virtue of this amendment claims 1 and 32 have been amended. Accordingly, claims 1-57 are currently under consideration. Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any subject matter of the claims as previously presented.

The specification has also been amended to add paragraph [0036.1] in accordance with MPEP § 714. The subject matter of paragraph [0036.1] is fully supported throughout the specification as filed; accordingly, no new matter has been added.

Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment. The attached page is captioned "**VERSION WITH MARKINGS TO SHOW CHANGES MADE**".

Rejection under 35 U.S.C. § 112, ¶2

The Office has rejected claim 32 as lacking proper antecedent basis. In response, claim 32 has been amended accordingly.

Applicant respectfully requests the reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, ¶2.

Rejection under 35 U.S.C. § 102(e)

The Office has rejected claims 1-9, 11, 13-16, 19, 21-23, and 26-36 as allegedly being anticipated by Roue (U.S. Pat. No. 6,350,270).

In support of the rejection, the Office Action states on p.3:

Roue teaches an embolizing device for insertion into an aneurysm. Roue teaches the device including a member 16 configured to be sealed within a membrane 24. The member is attached to the end of a delivery device for insertion into an aneurysm and the member and liner are expanded for filling the aneurysm void. In figure 4, a plurality of members 16 and 40.

Independent claim 1, as amended, recites "at least one self-expanding member". Support is found throughout the specification. As described, the self-expanding member reconfigures from a first configuration into a larger, expanded configuration causing the membrane to expand. (Specification, [0013] & Figs. 2A to 3B.) On the other hand, Roue shows and describes a coil 16 (member) which is designed to cause "its proximal end 18 to move away from the proximal end 32 of liner 24." (Roue, 3: 49-50.) This is accomplished by biasing the coil or making it highly flexible. An embolic agent is then filled into the liner to expand it. (Roue, 3: 48-56 & Fig. 4.)

Roue fails to show or describe a self-expanding member. Rather, the coil 16 (member) is merely designed to be biased to reconfigure its shape rather than self-expand. Therefore, Roue cannot anticipate amended claim 1 and dependent claims 2-9, 11, 13-16, 19, 21-23, and 26-36, which depend ultimately from claim 1 are patentable for at least the same reasons.

Accordingly, Applicant respectfully requests the reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(e).

Allowable Subject Matter

The Office has indicated that claims 38-57 are allowable over the art of record. The Office has further indicated that claims 10, 12, 17, 18, 20, 24, 25, and 37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant acknowledges the allowable claims with thanks. However, the base claims and intervening claims are believed patentable for at least the reasons stated above. Accordingly, Applicant respectfully requests the allowance of all claims.

CONCLUSION

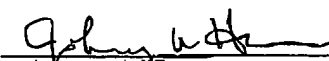
Applicant has, by way of the amendments and remarks presented herein, made a sincere effort to overcome rejections and address all issues that were raised in the outstanding Office Action. Accordingly, reconsideration and allowance of the pending claims are respectfully requested. If it is determined that a telephone conversation would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 509192000100. However, the Assistant Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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VERSION WITH MARKINGS TO SHOW CHANGES MADE**In the Specification:**

Please add paragraph [0036.1] after paragraph [0036] as follows:

[0036.1] Fig. 18 shows a catheter assembly having a catheter shaft attached to a fluid delivery attachment at a proximal end and to the self-expanding balloon assembly at a distal end.

In the Claims:

1. (Amended) An embolizing device for insertion into an aneurysm, comprising:
at least one self-expanding member configured to be sealed within a membrane;
the membrane defining a volume and further defining at least one orifice in a surface of the membrane.

32. (Amended) The embolizing device of claim 1 wherein the [distensible] membrane comprises a wall having a thickness of about 0.001 inches.